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RECORD OF ORAL HEARING

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JURGEN SCHMIDT-THUMMES, JURGEN HARTMANN and CHUNG-JI TSCHANG

Appeal 2010-003287
Application 10/541,206
Technology Center 1700

Oral Hearing Held: Tuesday, January 11, 2011

Before ADRIENE L. HANLON, PETER KRATZ and
LINDA M. GAUDETTE, *Administrative Patent Judges.*

APPEARANCES:

ON BEHALF OF THE APPELLANT:
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The above-entitled matter came on for hearing on Tuesday, January 11, 2011, commencing at 12:59 p.m., at the U.S. Patent and Trademark Office, 600 Dulany Street, 9th Floor, Hearing Room A, Alexandria, Virginia, before Lori B. Allen, notary public.

PROCEEDINGS

THE CLERK

: Appeal Number 003287, Mr. Koschmieder.

JUDGE HANLON: Before we start, I'd just like to ask who is attending in the back. I see you're from the outside?

OBSERVER 1: Yes, I'm just observing.

JUDGE HANLON: Okay. And you are as well?

OBSERVER 2: I'm observing as well. I'm with an attorney on later.

JUDGE HANLON: Okay. So, Mr. Koschmieder, you have 20 minutes. Whenever you're ready, you can begin.

DR. KOSCHMIEDER: Okay. Just to be sure that this is correct on the record, today we're in an oral hearing for Application Number 10/541206. Should I spell my name for the record also?

JUDGE HANLON: If you have a card, she could take that either now or after the --

DR. KOSCHMIEDER: Okay. In any case, let me spell it for you, because it's not an easy name. First name, Stefan, S-t-e-f-a-n; last name, Koschmieder, K-o-s-c-h-m-i-e-d-e-r. And, if it pleases the board, I'll just start with some comments unless you have some questions you'd like to start with.

JUDGE HANLON: No. You may begin.

DR. KOSCHMIEDER: Thank you.

We have a rejection that starts with what I'm going to call the Orsowicki reference or Ostrowicki reference. Spelling is O-s-t-r-o-w-i-c-k-i,

U.S. Patent 591,534, an obviousness rejection. The examiner has taken the position that the claimed invention is very similar to what is described in Ostrowicki, except for the particular feature of the order of addition or the order of a neutralization of a monomer. And the examiner has taken the position that that order or addition would be rendered obvious by modification of Ostrowicki in view of some other prior art. But, first of all, what I'd like to do is take a minute to talk about Ostrowicki and explain how Ostrowicki is already distinguished in the specification.

So in the original specification -- I believe it's on page 1 or page 2 -- there are some references given to other applications; in particular, European Application identified as EPB 819708; and, just for the record, that represents the European equivalent that corresponds with Ostrowicki, which is a side of this prior art in this case. The point or the reason I bring that up is to make it clear that applicants are aware of the Ostrowicki reference and the application was drafted with that in mind.

Now, of course, as the Examiner has conceded, Ostrowicki does not in fact describe the feature of our invention with respect to the order of neutralization; and, just to make this clear, the order of neutralization that is recited in our claims is such that the monomers -- that is, the carboxylic acid containing monomer units -- are subjected to neutralization prior to polymerization. If we look at the Ostrowicki patent and compare that with the examples in our specification and our disclosure, you see that what that difference boils down to in some embodiments is that in Ostrowicki they have several feed lines that can concurrently lead to a reactor. And they feed all of the feeds concurrently. They mix together as they enter the reactor, so

polymerization is occurring concurrently, at best, in Ostrowicki.

Now, we can contrast that with our examples in the original specification where we are describing the mixture of two feed lines, at least two feed lines together, those feed lines being our carboxylic acid-containing monomer and a base. So what that boils down to is as those feed lines mix prior to their entry into the reactor, you have neutralization of the monomer mixture before polymerization. And that is the aspect of the invention, or at least one of the aspects of the invention, that is not described in Ostrowicki.

So we have a series of examples and comparative examples in the specification, and to date the examiner hasn't given that information much weight in determining patentability; and, I just wanted to point out that our inventive example 1 and our comparative example 1 are, in fact, a comparison against Ostrowicki or intended as a comparison against Ostrowicki and to show the importance or the consequence of carrying out the neutralization as we have claimed.

Our example 1 has mixing of the base and the carboxylic acid-containing monomer before entry into the reactor compared to example 1 does not. And, the consequence of that is a lowered amount of what's called coagulum in our specification. I guess the layman might just call it sticky stuff that interferes with later filtration. So Appellant's' view is that the evidence of record should weigh in favor of patentability, if we, for the purposes of argument only, accept that a prima facie case was established, there is evidence of record to rebut that prima facie case of obviousness.

So that would be the first point that we would make with respect to the rejection, that there is, in fact, evidence supportive of non-obviousness.

In at least one instance the Examiner appeared to take the position that the examples of Ostrowicki either don't have very much coagulate or coagulum in comparison to what we have described in our examples; and, if I could just draw the board's attention to -- this will be examples 3 and 4, which are in columns 9 and 10 of Ostrowicki.

The Ostrowicki patent describes the amount of coagulate; and, for example, if one looks at the table representing Example 3, it would be the line that's sixth from the bottom; and that's giving an indication of the percentage of the coagulate that is formed in the Ostrowicki example. For example, in experiment number 3, the coagulate is present in an amount of 0.1 percent, which is about a thousand ppm. When we compare that with our inventive example, we're getting about a hundred ppm. So we have a substantial reduction in coagulum in our inventive example in comparison with the coagulate formed.

JUDGE GAUDETTE: The Examiner made the remark that you only have one example, and that is not commensurate in scope with the claims, because you're only testing very specific monomers. And did you respond to that at all? That's on page 10 of the answer.

DR. KOSCHMIEDER: We have pointed out to the Examiner that it is, in fact,what I would call a side-by-side comparison; and, if we look at examples 3 and 4 of Ostrowicki and look at the types of monomers, the types of reactants that are present, those are also present in our inventive example.

JUDGE GAUDETTE: But you have a very broad range that you're claiming, and you're only testing one specific set of monomers and one

specific amount of monomers. So how do we know that if you were to test different weight percentages of those same monomers or different monomers, and the only difference being the partial neutralization took place before polymerization?

DR. KOSCHMIEDER: Well, I would argue -- Appellants would argue -- that it makes sense. Or, that particular comparison is in fact commensurate in scope, because the Examiner even comes out and concedes -- and I read from the office action -- the only difference between the claims process for preparing a stable, aqueous copolymer version and the prior art is that partial neutralization of the ethylanically unsaturated carboxylic acids or dicarboxylic acids occurs prior to polymerization.

So on the one hand -- I understand your point, but on the one hand, the Examiner says, "Well, it's all the same except for this point. So if we distill out the important point identified by the Examiner and show that that important point, the neutralization prior to polymerization, is in fact the basis of a substantial difference in performance.

JUDGE GAUDETTE: Right. But the Examiner has relied on secondary references to show that it would be obvious to modify the primary reference to include that or to change the order of the steps.

DR. KOSCHMIEDER: Mm-hmm. Well, we can look at, for example, Basu, which is one of the secondary references.

JUDGE GAUDETTE: And I don't think you presented any arguments in your brief directed to the secondary references. So we really can't consider any thing that you didn't raise in your appeal brief.

DR. KOSCHMIEDER: The board can take that position. The

fact of the matter is there is evidence in the specification directly comparing the effect of the prior addition, or I should say the neutralization of the monomers, prior to polymerization. That is the important effect also where the difference identified by the Examiner between the claimed invention and the prior art, that hasn't been given any weight, so -- up-to-date -- by the Examiner in prosecution.

That is evidence that should be considered as probative of patentability. So I think the answer that I can give you today is that in fact, when we look at the Ostrowicki disclosure, when we compare the materials that are present in the Ostrowicki examples with what we've described in the specification in our own examples, it is nearly a side-by-side comparison, and it identifies or isolates the one particular difference identified by the Examiner as being critical.

If we, in fact, look at the secondary references, for example, like Basu, there are substantial differences between what is described in secondary references with respect to the composition of the materials that are subjected to polymerization. So whereas our claims recite a very particular mixture of monomers, having a particular maximum amount of the carboxylic acid-containing materials, the Basu and the other references describe different monomer mixtures.

So the question -- and not the question, but the fact is what becomes a comparison that is in fact commensurate in scope: one in which we've identified or isolated the particular difference between the claimed invention and the prior art should be given at least some weight towards patentability.

Did you have another question, another comment?

JUDGE GAUDETTE: No.

DR. KOSCHMIEDER: Okay. And I could just take one brief moment to point out that following on the question that, in fact, the materials that are present in the Ostrowicki examples 3 and 4, if we look, for example, in column 9, the Trilon B is also reproduced in the examples of the specification. The emulsifier is also the emulsifier used in the examples of our specification.

The APS is just a sulfate material. They use an ammonium cation in the Ostrowicki; sodium cation is used in the examples of our specification. Both the Ostrowicki and the inventive examples describe polymerization of mixtures of styrene, butadiene, and acrylic acid. So there are very direct side-by-side comparisons, so to speak, with respect to the art that's described, or the example that's described, in Ostrowicki.

In another, I believe it was in the Examiner's answer, the Examiner made some comment that the coagulate and the deposits that are described in the examples of the Ostrowicki patent may, in fact, be the same thing, and the Examiner pointed to some disclosure in which deposits -- the word "deposits" -- was followed in parentheses with the word "coagulate." And that is at column 4, line 41. It appears that the Examiner is implying that deposits are the same thing as coagulate, and the fact that the Ostrowicki patent doesn't describe the formation of any deposits is somehow evidence that no coagulate or coagulum is formed in the Ostrowicki examples. But if you look at the tables, you see clearly that there is, in fact, a difference between the formation of deposits and the formation of coagulate, because all

of the examples describe reactions that are carried out such that they are free of deposits, but they still include coagulate. So I wanted to address that point, as well.

Another point that comes to mind with respect to one of the secondary references is relevant to this point about deposits. One of the bases for alleging that it would be obvious to modify the Ostrowicki patent in the manner that we've claimed is that the Basu, B-a-s-u, reference, suggests that you can get lower amounts of deposits by carrying out a polymerization using certain temporal requirements. But if we look at the examples of Ostrowicki, we see that none of those examples does, in fact, form any deposit. So the point I'm making is that, in fact, it just doesn't make sense to assert that it would be obvious to modify Ostrowicki in a manner that would reduce the number of deposits in view of the fact that the examples show there are no deposits formed.

Those are all of the comments that I would like to make. Are there any other questions that I can answer from the board?

JUDGE HANLON: Do you have any questions?

JUDGE KRATZ: That's it.

DR. KOSCHMIEDER: Thank you.

JUDGE HANLON: Thank you very much.

[The hearing was concluded at 1:15 p.m.]